REMARKS

I.   INTRODUCTION

Claims 1, 4-7, 9, 12 and 13 have been amended. The Specification and Drawings have also been amended. Claim 11 has been cancelled. Thus, claims 1-10 and 12-20 are now pending in the present application. No new matter has been added. In light of the above amendments and the following remarks, Applicants respectfully submit that all presently pending claims are in condition for allowance.

II.   THE DRAWING OBJECTIONS SHOULD BE WITHDRAWN

The Drawings are objected to because Figure 2 does not comply with 37 C.F.R. § 1.84(p). (See 3/18/09 Office Action, p. 2.) In view of the amended drawings submitted herewith, it is respectfully submitted that this objection should be withdrawn.

III.   THE SPECIFICATION OBJECTION SHOULD BE WITHDRAWN

The Specification is objected to because of the use of the acronym "DCMR" in paragraph [0040] (See 3/18/09 Office Action, p. 3). Paragraph [0040] has been amended to recite the definition of this acronym. The acronym is defined in the Digital Imaging and Communications in Medicine Supplement 26 document, which Applicants refer to in paragraph [0011]. Thus, Applicants respectfully request withdrawal of the objection to the specification.

IV.   THE 35 U.S.C. § 101 REJECTIONS SHOULD BE WITHDRAWN

Claims 1-12 stand rejected under 35 U.S.C. §101 for being directed toward non-statutory subject matter. (See 3/18/09 Office Action, pp. 3-4). Specifically, the Examiner asserts that a method/process claim must be tied to another statutory class of invention or transform underlying subject matter to a different state or thing. (See Id.).

Claim 1 has been amended to recite that the steps are performed "by a processor." These amendments are supported by at least paragraphs [0047] – [0054] of the published application. Accordingly, claim 1 is tied to another statutory class, namely, a processor. Thus, Applicants respectfully submit that the rejection of claim 1 should be withdrawn. As claims 2-11 depend from, and therefore include all the limitations of claim 1, it is hereby submitted that these claims are also allowable.

Claim 12 has been similarly amended to recite a processor. Thus, claim 12 is also allowable.

V.   THE 35 U.S.C. § 103(a) REJECTIONS SHOULD BE WITHDRAWN

Claims 1 and 2 stand rejected under 35 U.S.C. §103(a) for being unpatentable over U.S. Patent No. 6,160,866 to Mazess et. al. (hereinafter "Mazess") in view of U.S. Patent No. 6,081,786 to Barry et al. (hereinafter "Barry"). (See 3/18/09 Office Action, pp. 5-6).

Claim 1 recites, in relevant part, "receiving, by the processor, guidelines relating to determination of the at least one characteristic from the examination" and "selecting, by the processor, one of the established norms to be applied to the patient based on the at least one characteristic, the guidelines relating to the determination of the at least one characteristic and the information about the patient other than from the examination."

The Applicants note that the Examiner correctly admitted that Mazess does not disclose the recitation of "receiving, by the processor, guidelines relating to determination of the at least one characteristic from the examination." (See 3/18/09 Office Action, p. 6). However, previous to this admission, the Examiner stated that Mazess discloses the recitation of "selecting, by the processor, one of the established norms to be applied to the patient based on the at least one characteristic, *the guidelines*

relating to the determination of the at least one characteristic and the information about the patient other than from the examination." (See 3/18/09 Office Action, p. 5).

Applicants fail to understand how the Examiner can assert that Mazess discloses the selecting step based on *"the guidelines relating to the determination of the at least one characteristic"* when the Examiner has admitted that Mazess does not disclose receiving such information. Even if the secondary reference (Barry) disclosed the recitation not disclosed by Mazess (which it does not as described in detail below), there still would be no disclosure or suggestion within either of the references to "select[], by the processor, one of the established norms to be applied to the patient *based on* the at least one characteristic, *the guidelines relating to the determination of the at least one characteristic* and the information about the patient other than from the examination" as recited in claim 1.

Specifically, the portion of Mazess cited by the Examiner to disclose the above limitation is entitled "Dual Femur Studies," which begins at col. 29, line 23, and ends at col. 32, line 35. This portion of Mazess discloses an automated system for measurement of both the left and right femur after initial localization and determination of one femur. (See Mazess, col. 29, lines 63-65). After the determination of bone densities of the first femur is complete, the computer program uses pre-programmed information about anatomical distances to provide an estimate of the starting point to scan the other femur. (See Mazess, col. 29, line 65 to col. 30, line 4). A "region of interest" is located on the first femur during the examination. (See Mazess, col. 31, lines 17-24). The patient's height and weight may be used in conjunction with the pre-programmed anatomical distance data to quickly locate a starting point for measuring the second femur. (See Mazess, col. 30, lines 63-65 and col. 31, lines 29-34). The location is approximated based on the combination of 1) the pre-programmed anatomical data, 2) adjusted for the patient's height and weight, and 3) the known location of the region of interest on the first femur. None of these factors could be considered "guidelines relating to *determination* of the at least one characteristic" as recited in claim 1. That is, the Examiner appears to be interpreting this recitation as "guidelines relating to the at least

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one characteristic" without the term determination. This is an incorrect interpretation of the actual recitation of claim 1. The factors of Mazess have nothing to do with the "determination of the at least one characteristic" as recited in claim 1. Thus, Mazess neither teaches nor suggests "selecting, by the processor, one of the established norms to be applied to the patient based on the at least one characteristic, the guidelines relating to the determination of the at least one characteristic and the information about the patient other than from the examination" as recited in claim 1.

The Examiner cites Barry to disclose the recitation of "receiving, by the processor, guidelines relating to determination of the at least one characteristic from the examination" (See 3/18/09 Office Action, p. 6). Barry discloses a knowledge base of treatments 21, a knowledge base of expert rules 22 and a knowledge base of advisory information 23. (See Barry, col. 5, lines 7-21; col. 8, lines 5-20; and Fig. 2). The Examiner does not specifically state which of these knowledge bases is analogous to the recited "guidelines relating to the determination of the at least one characteristic." However, Applicants respectfully submit that none of these knowledge bases are analogous.

Specifically, the knowledge base of therapeutic treatment regimes 21 includes a list of drugs that are used to treat specific diseases. (See Barry, col. 5, lines 22-48). The knowledge base of expert rules 22 is a set of rules established for treating a disease. (See Barry, col. 10, line 33 – col. 11 line 60). Applying the rules to the treatment generates the knowledge base of Advisory Information 23. (See Barry, col. 5, lines 12-21; and col. 5, line 50 – col. 6, line 35). Thus, none of these knowledge bases include "guidelines relating to *determination* of the at least one characteristic" as recited in claim 1. As described above, the Examiner appears to be reading out the term "determination" when interpreting this recitation of claim 1. When interpreted properly, it should be apparent that the knowledge bases of Barry are not related in any manner with the "determination of the at least one characteristic" as recited in claim 1.

Accordingly, neither Mazess nor Barry, alone or in combination, disclose or suggest "receiving, by the processor, guidelines relating to determination of the at least one characteristic from the examination" and "selecting, by the processor, one of the established norms to be applied to the patient based on the at least one characteristic, the guidelines relating to the determination of the at least one characteristic and the information about the patient other than from the examination" as recited in claim 1. Thus, Applicants respectfully submit that claim 1 is allowable. Because claim 2 depends on and therefore contains all of the limitations of claim 1, it is respectfully submitted that this claim is allowable.

Claim 3 stands rejected under 35 U.S.C. §103(a) for being unpatentable over Mazess in view Barry and in further view of the Official Notice that calculating a ratio of measured values is well known in the art. (See 3/18/09 Office Action, p. 7).

Claims 4-5 stand rejected under 35 U.S.C. §103(a) for being unpatentable over Mazess in view Barry and in further view of U.S. Patent No. 5,928,168 to Laros (hereinafter "Laros"). (See 3/18/09 Office Action, pp. 8-9).

Claim 6 stands rejected under 35 U.S.C. §103(a) for being unpatentable over Mazess in view Barry and in further view of Laros, and in even further view of the Official Notice that calculating a ratio of measured values is well known in the art. (See 3/18/09 Office Action, pp. 9-10).

Claims 7-9 stand rejected under 35 U.S.C. §103(a) for being unpatentable over Mazess in view Barry and in further view of U.S. Patent No. 6,260,021 to Wong et. al. (hereinafter "Wong") (See 3/18/09 Office Action, pp. 10-11).

Claim 10 stands rejected under 35 U.S.C. §103(a) for being unpatentable over Mazess in view Barry and in further view of Wong, and in even further view of the Official Notice that it is well known in the art to use coding to indicate information about a patient. (See 3/18/09 Office Action, p. 12).

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Applicants respectfully submit that alone, nor in any possible permutation of combinations, do the prior arts of Mazess, Barry, Laros, Wong, Sasmor, or either of the Official Notices provided by the Examiner cure the deficiencies presented above with regard claim 1. Because claim 3-10 depend on and therefore contains all of the limitations of claim 1, it is respectfully submitted that these claims is allowable for at least the same reasons given above for claim 1.

Furthermore, Applicants respectfully submit that the Examiner has not properly taken Office Notice. The Examiner merely provides conclusory statements with respect to ratios of values and coding of information based on personal knowledge. As noted in the MPEP, "Official Notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known." (See MPEP § 2144.03(a)). While the Examiner asserts that the ratios of values and coding of information are old and well known in the art, he fails to provide an instant and unquestionable demonstration that these claimed components are well-known in the art. As further noted in the MPEP, "there must be some form of evidence in the record to support an assertion of common knowledge. See Lee, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is 'basic knowledge' or 'common sense' to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection)." (See MPEP § 2144.03(b)). The Examiner does not provide any evidence that the ratios of values and coding of information would be basic knowledge to one of ordinary skill in the art. The only support that the Examiner provides for his assertion is his personal knowledge and understanding of the ratios of values and coding of information. According to the MPEP, "if the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding." (See MPEP § 2144.03(c); and 37 CFR 1.104(d)(2)). Thus, Applicants respectfully submit that

without the requisite affidavit or declaration to support the Examiner's personal knowledge of ratios of values and coding of information, the Examiner's use of Office Notice is improper.

Claim 11 has been cancelled. Applicants respectfully submit that the rejection to the claim should be withdrawn.

Claim12 stands rejected under 35 U.S.C. §103(a) for being unpatentable over Mazess in view Wong and in further view of Barry. (See 3/18/09 Office Action, pp. 14-16).

Claim 12 recites, in relevant part "receiving, by the processor, guidelines relating to determination of the at least one characteristic from the examination, the guidelines being described using a methods ontology based on semantic web technology" and selecting, by the processor, one of the established norms to be applied to the patient based on the at least one characteristic, the guidelines relating to the determination of the at least one characteristic and the information about the patient other than from the examination."

As described above, neither Mazess nor Barry disclose or suggest these recitations. Applicants respectfully submit that Wong does not cure these deficiencies of Mazess and Barry. Thus, Applicants respectfully submit that claim 12 is allowable.

Claims 13, 14, 19, and 20 stand rejected under 35 U.S.C. §103(a) for being unpatentable over Mazess in view of Barry. (See 3/18/09 Office Action, pp. 16-18).

Claim 13 recites, in relevant part, "said processor being arranged to receive the characteristics of the patient derived by said modality, medical information about the patient from said repository of medical information, the norms from said at least one library of norms and the clinical guidelines from said at least one library of clinical guidelines and select one of said norms which is most appropriate for use with the

patient." Thus, applicants respectfully submit that for the same reasons described above with respect to claim 1, claim 13 is allowable over Mazess and Barry. Because claims 14, 19 and 20 depend from, and therefore include all the limitations of claim 13, it is respectfully submitted that these claims are also allowable.

Claims 15-17 stand rejected under 35 U.S.C. §103(a) for being unpatentable over Mazess in view Barry and in further view of Wong. (See 3/18/09 Office Action, pp. 18-19).

Claim 18 stands rejected under 35 U.S.C. §103(a) for being unpatentable over Mazess in view Barry and in further of the Official Notice that data accessed over the Internet uses methods ontology based on semantic web technology.. (See 3/18/09 Office Action, pp. 19-20).

Applicants respectfully submit that alone, nor in any possible permutation of combinations, do the prior arts of Mazess, Barry, Wong, or the Official Notices provided by the Examiner cure the deficiencies presented above with regard claim 13. Morover, the Applicants dispute the Examiner's use of Official Notice in the same manner as described above. Because claim 15-18 depend on and therefore contains all of the limitations of claim 13, it is respectfully submitted that these claims is allowable for at least the same reasons given above for claim 13.

CONCLUSION

In light of the foregoing, Applicants respectfully submits that all of the presently pending claims are in condition for allowance. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully Submitted,

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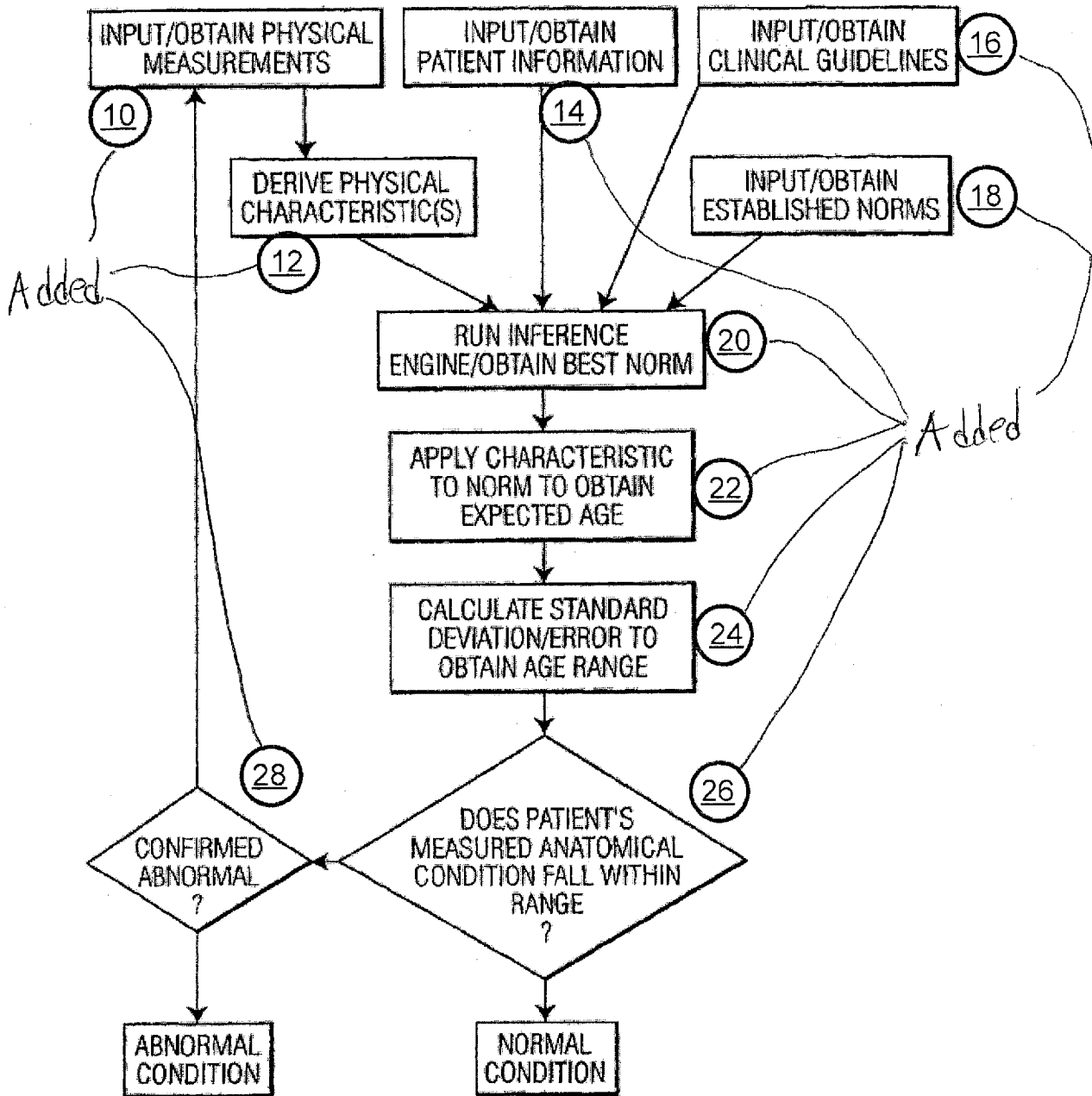FIG. 2